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REEXAM UNIT

In re reissue application of
Nally, et al.
Serial No. 09/374,041
Filed: August 13, 1999
For: U.S. Patent No. 5,598,525

In re Nally, et al.
Reexamination Proceeding
Control No. 90/005,471
Filed: August 13, 1999
For: U.S. Patent No. 5,598,525

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: DECISION, SUA SPONTE,
: TO MERGE REEXAMINATION
: AND REISSUE PROCEEDINGS
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The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,598,525 issued to Nally, et al. on January 28, 1997.

FORWARDED

2. A request for reexamination of the `525 patent was filed on August 13, 1999, by patent owner and the resulting reexamination proceeding was assigned Control No. 90/005,471.
3. On the same date, August 13, 1999, patent owner filed a reissue application which was assigned Application No. 09/374,041.
4. Notice of the filing of the reissue application was published in the *Official Gazette* on September 28, 1999.
5. On October 21, 1999, reexamination was ordered in the `5471 proceeding.
6. A non-final Office action was mailed in the `5471 proceeding on July 31, 2000, which set a shortened statutory period for response of one month, due to concurrent litigation that has been stayed.
7. A request for an extension of time was filed in the `5471 proceeding on August 28, 2000, and a two month extension of time was granted in a letter mailed on September 13, 2000.
8. A response to the Office action in the `5471 proceeding was filed on October 31, 2000.
9. A final Office action was mailed in the `5471 proceeding on March 14, 2001, which set a shortened statutory period for response of one month.
10. A request for an extension of time was filed in the `5471 proceeding on April 12, 2001, and a one month extension of time was granted in a letter mailed on April 17, 2001.
11. A response to the final Office action in the `5471 proceeding was filed on May 14, 2001, accompanied by a request for an extension of time for one month.
12. On the same date, May 14, 2001, patent owner filed a Notice of Appeal in the `5471 proceeding.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5471 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '5471 reexamination file shows that an amendment was filed with the original reexamination request. Claims 1, 13, 15-16, 25, 34, 37, 40-41 and 43 have been amended, and new claim 48 has been added in the '5471 reexamination proceeding. Patent owner has filed a response to the most recent Office action, accompanied by a request for an extension of time, and a Notice of Appeal.

A review of the reissue (Application No. 09/374,041) prosecution history shows that the reissue application was published in the *Official Gazette* on September 28, 1999. Two months from the publication of the present reissue have passed, and the application is awaiting a first Office action on the merits by the examiner. In a preliminary amendment, in addition to amending portions of the specification (Cols. 3 and 5-14), as well as amending patent claims 1-2, 5, 7-9, 13, 15-16, 20, 23-26, 28-30, 34-37, 39-41, and 43-45, in the reissue application, applicant

has submitted new claim 48 for consideration, Thus, the specification and claims are not identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/374,041, and Control Number 90/005,471. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, i.e., the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature.

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner

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upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

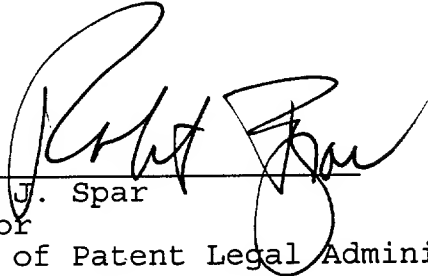
Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continued prosecution of the reexamination proceeding.

CONCLUSION

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1. The above-identified reissue application and reexamination proceeding ARE MERGED into a single consolidated proceeding.
2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 2600. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding.
4. The examiner should withdraw the finality of the previous Office action in the reexamination proceeding, and issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding pursuant to Part III of this decision, **after** the earlier of the following events have occurred:
 - (a) the submission of the housekeeping amendment to place the same amendments in both cases; or
 - (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the housekeeping amendment.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.



Robert J. Spar
Director
Office of Patent Legal Administration

June 6, 2001

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